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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,564

12/27/2005

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07/20/2009

EXAMINER

PRANGE, SHARON M

ART UNIT

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3728

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DELIVERY MODE

07/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,564	Applicant(s) KUBO ET AL.	
	Examiner SHARON M. PRANGE	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/14/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation “a member having a greater Young’s modulus than the first arch” in lines 21-22. It is not clear whether this is the same member as the reinforcing member recited in line 3, or a different member. For purposes of examination the member recited in line 21 is treated as the same as the originally recited reinforcing member in line 3.

Claim 2 recites the limitation “a member having a greater Young’s modulus than the first arch” in lines 29-30. It is not clear whether this is the same member as the reinforcing member recited in line 6, or a different member. For purposes of examination the member recited in line 29 is treated as the same as the originally recited reinforcing member in line 6.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9, 11-13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita (US Patent Application No. 2003/0005600), herein Kita '600.

Regarding claims 1-3, 5, and 16-19, Kita '600 discloses a shoe sole having an outer sole (outsoles 4, 5), a midsole (3) attached to the outer sole, and a reinforcing member (lower portion 22 of shank member 20). The midsole has a first arch formed of a resin foam. The reinforcing member has a second arch covered by the first arch. The reinforcing member is arranged so that the top surface of the second arch is not in contact with part of the bottom surface of the first arch; the two arches are vertically spaced from one another. The non contact areas of the arches can therefore deform independently of one another. The first and second arches form four curved surfaces (paragraphs 0033, 0045; Fig. 5, 12-14).

Regarding claims 4, 6, 8, and 12, Kita '600 discloses that the reinforcing member has two side portions (22a) on the medial and lateral sides which are bonded to the midsole so that the entire peripheral edge of the member is bonded to the midsole (paragraph 0050; Fig. 12-14).

Regarding claim 11, Kita '600 discloses that the first arch may be made of foam of ethylene-vinyl acetate polyurethane and the reinforcing member may be made of non-foam of polyurethane (paragraphs 0034, 0036).

Regarding claim 13, Kita '600 discloses that the outer sole is separated into a fore foot part (5) and a rear foot part (4). The fore end and rear ends parts of the reinforcing member are sandwiched between the outer sole and the midsole (Fig. 5).

Regarding claim 15, Kita '600 discloses a second reinforcing member (portion 21) (paragraph 0045).

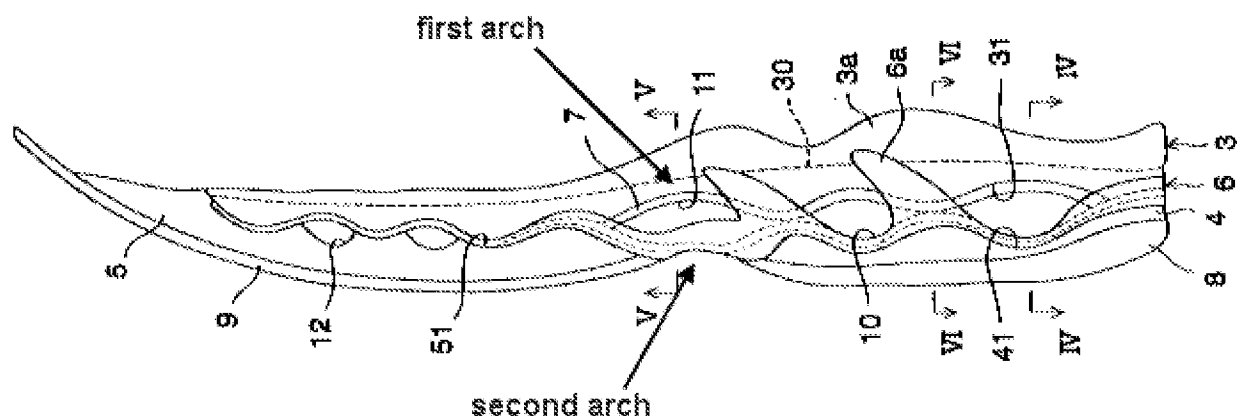
Kita '600 does not specifically disclose that the reinforcing member has a Young's modulus greater than that of the first arch of the midsole. Kita '600 does disclose that the reinforcing member provides increased rigidity and is made of thermoplastic resin as opposed to the soft elastic material of the midsole. It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the Young's modulus of the reinforcing member greater than that of the first arch in order to allow the reinforcing member to provide a greater rigidity than the midsole.

3. Claims 1-6, 11, 12, 14, 15, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita (US Patent No. 6,625,905), herein Kita '905.

Regarding claims 1-3, 5, and 17-19, Kita '905 discloses a shoe sole having an outer sole (outsoles 8, 9), a midsole (3, 4, 5) attached to the outer sole, and a reinforcing member (lower corrugated sheet 6). The midsole has a first arch formed of a resin foam. The reinforcing member has a second arch covered by the first arch. The

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reinforcing member is arranged so that the top surface of the second arch is not in contact with part of the bottom surface of the first arch; the two arches are vertically spaced from one another. The non contact areas of the arches can therefore deform independently of one another. The first and second arches form four curved surfaces (column 4, lines 17-27; Fig. 3).



Regarding claims 4, 6, and 12, Kita '905 discloses that the reinforcing member has two side portions (flanges 6a) on the medial and lateral sides which are bonded to the midsole (column 5, lines 14-18; Fig. 3).

Regarding claim 11, Kita '905 discloses that the first arch may be made of foam of ethylene-vinyl acetate polyurethane and the reinforcing member may be made of non-foam of polyurethane (column 4, lines 31-40).

Regarding claim 14, Kita '905 discloses that the midsole has upper (3) and lower (4, 5) midsole bodies. The reinforcing member is sandwiched between the upper and lower bodies (Fig. 3).

Regarding claim 15, Kita '905 discloses a second reinforcing member (corrugated sheet 7) (column 4, lines 23-27; Fig. 3).

Kita '905 does not specifically disclose that the reinforcing member has a Young's modulus greater than that of the first arch of the midsole. Kita '905 does disclose that the reinforcing member provides increased rigidity and is made of thermoplastic resin as opposed to the soft elastic material of the midsole. It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the Young's modulus of the reinforcing member greater than that of the first arch in order to allow the reinforcing member to provide a greater rigidity than the midsole.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita '600, as applied to claims 1-6, 8, 11-13, and 15-19, in view of Polifroni (US Patent No. 6,854,199).

Kita '600 does not disclose an opening passing vertically through the second arch. Polifroni teaches providing openings (holes 66) passing vertically through a support member in order to allow ventilation through the piece to cool a wearer's foot. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided openings, as taught by Polifroni, to the reinforcing member of Kita '600 in order to allow ventilation to cool a wearer's foot.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON M. PRANGE whose telephone number is (571)270-5280. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. P./ 7/17/09
Examiner, Art Unit 3728

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728